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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,628	02/12/2001	Ursula Murschall	00/057 MFE	9521

7590

09/05/2003

ProPat, L.L.C.  
2912 Crosby Road  
Charlotte, NC 28211

EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/781,628

Applicant(s)

MURSCALL ET AL.

Examiner

Vivian Chen

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see DETAILED ADVISORY ACTION.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see DETAILED ADVISORY ACTION.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: DETAILED ADVISORY ACTION

Vivian Chen  
Primary Examiner  
Art Unit: 1773

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## **DETAILED ADVISORY ACTION**

### ***Response to Proposed Amendments***

1. The proposed amendments will NOT be entered because they raise new issues that would require further consideration and/or search (e.g., the newly proposed claim limitation regarding the presence of an acyclic olefin monomer).

### ***Response to Arguments***

2. Applicant's arguments filed 8/15/2003 have been fully considered but they are not persuasive.

(A) Regarding Applicant's statements regarding the ownership of copending Applications 09/791,447, 09/781,802, and 09/781,722, it is unclear how these Applications can be disqualified as the basis for double patenting rejections, since it appears that the present application is also owned by Mitsubishi Polyester Film GMBH and furthermore has up to three inventors in common. Is Applicant attempting to argue that the present Application was somehow not owned by Mitsubishi Polyester Film GMBH at the time the present invention was made? If so, Applicant should provide documentary evidence of said ownership. Or did Applicant, for some reason, mistakenly read the double patenting rejections (based on the copending Applications) as rejections under 35 USC 103(a)?

(B) Applicant's arguments with regard to SASAKI ET AL, JP '319, JP '349, and JP '717 not disclosing or suggesting the claimed COC/acyclic copolymer having a Tg greater than 110 C are moot since the proposed claim amendments have not been entered. Furthermore, in regards

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to Applicant's arguments regarding the copolymers in JP '319 having Tg values less than 100 C, the reference clearly teaches the use of PEN as the polyester component. Since PEN has a Tg of 115 C, the cycloolefin copolymer used in a PEN-containing blend would necessarily have a Tg of 125 C or more. Similarly, the 10 degree difference in Tg (between the cycloolefin and the polyester components) is merely a lower end value, therefore, there is nothing that preclude the cycloolefin copolymer used in the JP '319 from having a Tg of 110 C or more. Applicant has not provided probative evidence of unexpected results commensurate in scope with the present claims.

(C) In response to applicant's argument that the prior art fails to teach or suggest the use of the recited cycloolefins to reduce yellowing in materials containing regrind, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Since the use of recycled materials has well established cost and environmental benefits, Applicant has not provided probative evidence of criticality or unexpected results commensurate in scope with the present claims. While the examples in the specification indicate that that certain cycloolefin-containing compositions produce films with reduced yellowing in films incorporating regrind material, the showing in the specification is not commensurate in scope with the present claims, especially in regards to the Tg, type and amount of additives such as UV absorber, white pigment, brighteners, etc. Applicant has not provided probative evidence that similar non-yellowing properties are present in films containing COCs of different Tg values, or the use of different types and/or amounts of pigments and additives, especially when the

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specification fails to clearly set forth the compositions of the comparative Examples.

Furthermore, the Examiner notes that Applicant has not provided evidence of criticality and/or unexpected results based on comparisons against the closest prior art as represented by the JP '319 and JP '349 and JP '717, which each explicitly disclose polyester/cycloolefin blends. The Examiner also points out that additives such as UV absorbers, brighteners, etc. have well known effects and functions; therefore some degree of improvement in UV resistance and coloration is only to be expected from their use.

### *Conclusion*

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

August 28, 2003



Vivian Chen  
Primary Examiner  
Art Unit 1773